Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HUI-JUNG WU, JAMES S. DRAGE, TERESA RAMOS, DOUGLAS M. SMITH, STEPHEN WALLACE, KEVIN RODERICK, and LISA BETH BRUNGARDT

Appeal No. 2001-1058
Application No. 09/141,287

ON BRIEF

Before KRASS, JERRY SMITH, and GROSS, ***Administrative Patent Judges***.
GROSS, ***Administrative Patent Judge***.

REQUEST FOR REHEARING

In a decision dated February 20, 2004, the decision of the examiner rejecting all of the claims on appeal under 35 U.S.C. § 103 was affirmed. Further, a new ground of rejection under 35 U.S.C. § 112, second paragraph, was entered as to claims 3, 16, and 20.

Appellants begin (Rehearing, pages 2-3 and 5-6) by mischaracterizing statements made in the Decision. Specifically, appellants assert that the Board states in the Decision that

diethylene monomethyl ether and Smith's glycol solvent "have the same properties." However, what was actually stated was that Hawley indicates that diethylene glycol monomethyl ether satisfies the properties required by Smith (a certain boiling point and solubility in water), and that "the examiner concludes . . . that it would have been obvious to substitute diethylene glycol monomethyl ether for the solvent of Smith, since ***they have the same properties***" (page 5 of Decision, emphasis added). The properties referenced as being the same are thus the boiling point and the miscibility, not all properties, as insinuated by appellants.

Appellants further contend (Rehearing, page 3) that a single property in common, boiling point, "is legally insufficient to equate the two different classes of compounds." Appellants insist that there is nothing to suggest that the two types of solvents are equally useful. We disagree. As explained in the Decision (pages 4-5), Smith selects glycols as low volatility "solvent candidates" based on their boiling point ***and*** miscibility with water and ethanol (see column 5, lines 5-12). The use of the word "candidate" suggests that other types of low volatility solvents may be used so long as they have a boiling point in the range of 175-250°C and they are miscible with both water and ethanol. Smith repeats in column 16, lines 1-3, that other solvents may be used. Thus, the

suggestion for substituting diethylene glycol monomethyl ether for the glycols of Smith comes from the teaching in Smith that other low volatility solvents with the two stated properties may be used, not merely from the properties ***per se***. Consequently, in the absence of evidence to the contrary, the skilled artisan would have expected diethylene glycol monomethyl ether to produce results similar to those of Smith's glycols.

Appellants argue (Rehearing, page 5) that ethers and glycols are not analogs, homologs, or isomers of one another. In fact, appellants assert that there are such major structural differences between ethers and glycols "which would motivate those skilled in the art to *not* substitute the glycols of Smith with the ethers of the present invention." Although we agree that structural differences can be evidence of the nonobviousness of substituting one compound for another, we disagree that structural differences necessarily motivate one to refrain from substituting one for the other. Characteristics in common such as boiling point and miscibility, where the primary reference calls for such properties, is at least as compelling evidence in favor of substitution. Accordingly, we are not persuaded of any error in the obviousness rejection.

Appellants (Rehearing, pages 6-7) rely upon the same arguments addressed ***supra*** to dispute the obviousness type double patenting rejections. For the reasons discussed ***supra***, we are not persuaded of any error in the double patenting rejections.

Regarding the rejection of claim 3 under 35 U.S.C. § 112, second paragraph, upon reconsideration we find that claim 3 does not expand the scope of claim 1. The low volatility organic solvent recited in claim 3 is part of the organic solvent vapor atmosphere rather than part of the organic solvent composition, as recited in claim 1. Therefore, the solvents recited in claim 3 can be different from those recited in claim 1. Accordingly, we will withdraw the indefiniteness rejection of claim 3.

As to claim 16, appellants have not contested the rejection under 35 U.S.C. § 112, second paragraph. Instead appellants assert (Rehearing, page 7) that an amendment has been filed to overcome the rejection. Although the amendment does appear to overcome the rejection, until the amendment is actually entered (which is the examiner's decision), the rejection is still valid.

For claim 20, appellants argue (Rehearing, page 7) that "as long as a relatively low volatility solvent selected from the group . . . [recited in claim 1], and mixtures thereof is present at a

minimum, other solvents may also be present." Therefore, appellants assert that the rejection of claim 20 under 35 U.S.C. § 112, second paragraph, is improper. We disagree. Claim 20 does not clearly recite an additional organic solvent, for example, by using terminology such as "further comprises" or "additional organic solvent." Claim 20 reads, "wherein the alkoxysilane composition comprises at least one organic solvent selected from the group . . .," wherein the recited compositions are disclosed in the specification as being low volatility solvents. From the language of claim 20, is unclear whether the solvent recited is a ***further*** low volatility solvent or is the same low volatility solvent recited in claim 1, from which claim 20 depends. In other words, claim 20 at least is ambiguous, and under one interpretation broadens the scope of claim 1. Therefore, we are not persuaded of any error in the indefiniteness rejection of claim 20.

Appellants' request for rehearing has been considered and has been denied as to the rejection of all claims under 35 U.S.C. § 103 and as to the new ground of rejection of claims 16 and 20 under 35 U.S.C. § 112, second paragraph. However, the request has been granted as to the new ground of rejection of claim 3 under 35 U.S.C. § 112, second paragraph. In other words, the request for rehearing has been denied-in-part and granted-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

REHEARING
GRANTED-IN-PART

ERROL A. KRASS
Administrative Patent Judge

JERRY SMITH
Administrative Patent Judge

ANITA PELLMAN GROSS
Administrative Patent Judge

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